

DISCUSSION OF THE CLAIMS

Claims 1-8, 11, 14, and 17-20 are pending in the present application. Claims 9-10, 12-13 and 15-16 are canceled claims.

No new matter is added.

REMARKS

Applicants thank the Office for indicating that the subject matter recited in Claims 7 and 19-20 is allowable. Applicants further thank the Office for withdrawing the rejection of the claims in view of the Nukada reference (U.S. 5,298,617) set forth in the July 21, 2010 Office Action.

The Office now rejects the claims for lack of enablement under 35 U.S.C. § 112, first paragraph. The Office asserts that steps of filtering and washing are critical or essential to the practice of the invention.

The presently pending claims recite a “separating” step in which a grinding medium is separated from a mixture that includes a solvent and a phthalocyanine. Applicants submit that those of skill in the art readily recognize that the separating recited in the present claims can be carried out by methods other than the filtering and washing that the Office alleges is critical to the practice of the invention.

Applicants submit herewith evidence showing that those of skill in the art readily recognize that there are many ways to carry out solid/liquid separations. Other methods include centrifugation and gravity sedimentation, e.g., many ways in which grinding media can be separated from a mixture containing the grinding media, a phthalocyanine and a solvent to obtain a mixture containing the phthalocyanine and the solvent. See for example the pages of “Chemical Engineers Handbook,” J. H. Perry, 4<sup>th</sup> Edition, 1963 attached herewith. Applicants further draw the Office’s attention to well known texts including “Separation Processes,” 2<sup>nd</sup> edition, C. J. King (1980) and “Encyclopedia of Separation Technology,” volumes 1 and 2, D.M. Ruthven (1997) which likewise show that those of skill in the art readily recognize that the separating step recited in the present claims may be carried out in a manner other than the filtration and washing that the Office asserts is critical.

Applicants note that the disclosure of the present specification cited by the office as support for the rejection under 35 U.S.C. 112 does not require filtering and washing but instead provides these options as only an example which may be used to carry out the separating (see page 9, lines 11-14 of the as-filed disclosure).

After completion of the grinding, the solvent is used to remove the grinding media from the ground mixture. For example, the solvent is added to the ground mixture in a ratio of 1:4 to dissolve the ground mixture, thereby forming a slurry. Thereafter, the slurry is filtered, washed, and dried at 40.about.80.degree. C. for 3.about.20 hours. At this time, the washing is preferably carried out until the filtrate is neutralized (a pH of at least 7.0).

Applicants submit the evidence of record shows that those of ordinary skill in the art may practice the claimed invention without undue experimentation and thus respectfully request withdrawal of the rejection.

Applicants thank Examiner Zhang for the helpful and courteous discussion of February 18, 2011. During the discussion Applicants' U.S. representative pointed out that those of skill in the art readily recognize that different steps of separation may be used when carrying out a solid/liquid separation. Applicants' U.S. representative further pointed out that the particular X-ray diffraction spectrum recited in Claim 11 is different from any X-ray diffraction spectrum described in the Nukada reference.

Claim 11 describes an oxytitanium phthalocyanine charge generating material having a particular X-ray diffraction spectrum. The X-ray diffraction spectrum of Claim 11 includes peaks at 11.4, 13.7, 14.8, 18.8, 23.0 and  $28.8 \pm 0.2^\circ$ . Contrary to the Office's assertion, none of the phthalocyanine materials described in the Nukada reference has an X-ray diffraction spectrum meeting the requirements of Claim 11. Applicants thus respectfully request withdrawal of the rejection of Claim 11 as anticipated by Nukada.

For the reasons discussed above in detail, Applicants request withdrawal of the rejection and the allowance of all now-pending claims.

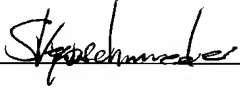
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